



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/784,909

02/24/2004

Nadia Gardel

05725.1339-00

6147

22852

7590

08/22/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

GEORGE, KONATA M

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

08/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/784,909 | <b>Applicant(s)</b><br>GARDEL ET AL. |  |
|                              | <b>Examiner</b><br>KONATA M. GEORGE  | <b>Art Unit</b><br>1616              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 80-186 is/are pending in the application.
- 4a) Of the above claim(s) 81,83 and 150-166 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 80,82,84-149 and 167-186 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/4/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 80-136 are pending in this application.

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on June 4, 2008 was noted and the submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

#### ***Action Summary***

Any rejections of record that are not repeated below are considered withdrawn.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 80, 82, 840149 and 167-186 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants use the phrase "greater than or equal to" in the claims when describing the ratio of (water + polyol) to oil; the silicone oil (claim 102); the total content of the solid particles (claim 175). It is unclear to the examiner if it is "greater than" or "equal to" are the intended values.

### ***Response to Arguments***

Examiner has withdrawn the rejection of record in lieu of the above rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 80, 82, 84-149 and 167-186 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 15 and 18-99 of U.S. Patent No. 10/603,698. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed to a water-in-oil foundation comprising at least one oil, an aqueous phase, a copolyol and a coloring material. The difference between the instant invention and the copending application is the weight percentages and concentrations of the components.

Art Unit: 1616

This determination would have been made through routine experimentation to achieve the desired results of the claimed invention. This is in the absence of any clear showing of unexpected results attributable to the specific concentrations of the components employed by applicant in the instant case.

### ***Response to Arguments***

Applicants request that the examiner holds the rejection in abeyance until there is an indication of allowable subject matter. The examiner can grant this request, the double patenting rejection is maintained and a terminal disclaimer is required to overcome the rejection.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 80, 84-117, 124-130, 140-149, 175, 176 and 178-186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanna et al. (US 5,843,417) in view of Elm et al. (US 4,552,753).

Applicant claims a water-in-oil foundation comprising at least one oil, an aqueous phase containing water and at least a water-miscible polyol and a dyestuff.

***Determination of the scope and content of the prior art***  
**(MPEP §2141.01)**

Hanna et al. disclose a water-in-oil emulsion comprising a water phase and an oil phase. The composition further contains a particle, surfactant, polymer and other ingredients that are common to cosmetic compositions (col. 1, line 49 through col. 2, line 13). Column 2, line 62 through column 3, line 44 teach the oil is a hydrocarbon-based oil such as isododecane and may also contain linear and cyclic silicone oils and the oil is in the emulsion at a concentration of 10-55 wt. %. Column 3, lines 45-67 teach that the emulsion can contain between 1-20 wt.% of pigment particles. Column 4, line 56 through column 5, line 10 teach that the emulsion can contain a surfactant such as dimethicone copolyol in a concentration of 5-15 wt. %. Column 6, lines 9-32 teach additional ingredients that are common to cosmetic compositions such as clays, propylene glycol, etc. in a concentration of 0.1 to 10 wt. %. The example in column 7, lines 24-53 also disclose the claimed invention.

***Ascertainment of the difference between the prior art and the claims***  
**(MPEP §2141.02)**

Hanna et al. do not teach the claimed concentration of the ingredients, the viscosity of the composition and the specific volatile silicone oils as claimed by applicant. It is for this that Elm et al. is joined.

Elm et al. disclose in column 2, lines 32-68 examples of cyclic and linear volatile silicone oils that are common for use in cosmetics. Examples of these are Dow Corning 344 (octamethylcyclotetrasiloxane/decamethylcyclopentasiloxane), Dow Corning 345

Art Unit: 1616

(decamethylcyclopentasiloxane/dodecamethylcyclohexasiloxane) or Dow Corning 200 (hexamethyldisiloxane), etc.

***Finding of prima facie obviousness***  
***Rational and Motivation (MPEP §2142-2143)***

It is within the ability of one of ordinary skill in the art to adjust the viscosity and concentration of the ingredients in the composition to arrive at the desired formulation through routine experimentation. This is in the absence of any clear showing of unexpected results attributable to the specific concentrations of the specific ingredients and viscosity of the composition employed by applicant in the instant case.

With respect to the specific silicone oils as claimed by applicant, it would have been obvious to one of ordinary skill in the art to look to the teachings of Elm et al. for examples of linear and cyclic volatile silicone oils that are commonly used in cosmetics. One would expect a reasonable chance of success as Hanna et al. describe broadly that cyclic and linear silicone oils are suitable for use in the invention.

***Response to Arguments***

Applicant's arguments filed June 4, 2008 have been fully considered but they are not persuasive.

Applicant argues that Elm teaches a process for making a roll-on composition comprising volatile oils, non-volatile oils, etc. It is argued that the compositions of Elm are not water-in-oil emulsions. The examiner agrees, however, Elm is relied upon to

Art Unit: 1616

teach examples of cyclic and linear volatile silicone oils that are common for use in cosmetics. As mentioned above, Hanna teaches that the composition may also contain linear and cyclic silicone oils.

Applicant argues that the absence of silicone oils is preferred in Hanna. The examiner disagrees. Lines 43-44 of column 3 states that the absence of silicone oils is **another** (emphasis added) preferred embodiment. This means that in addition to a composition comprising silicone oils, a composition that is absence of silicone oils can be made too.

Applicant repeats that that composition of Hanna and Elm has different forms. Examiner again states that Elm is relied upon to teach examples of the cyclic and linear volatile silicone oils that are common for use in cosmetics.

### ***Conclusion***

Claims 80, 82, 84-149 and 167-186 remain rejected.

### ***Telephone Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8:00AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached at 571-272-0646. The fax phone



Art Unit: 1616

numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Konata M. George/  
Primary Examiner, Art Unit 1616